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APR 12 2004

OFFICE OF PETITIONS

In re Application of
Sanford M. Stevenson
Application No. 09/652,272
Filed: August 31, 2000
Attorney Docket No. 1843-A-DIV-CIP-DIV

:
: NOTICE OF INTENT TO
: DISMISS PETITION
:

On July 31, 2001, a petition under 37 CFR 1.292 to institute public use proceedings against the claims in the above-identified application was filed. The petition was accompanied by, *inter alia*, proof of service, the petition fee set forth in 37 CFR 1.17(j), and Exhibits A-H. On July 31, 2001, a protest under 37 CFR 1.291 was also filed by the same party. The protest was accompanied by Exhibits A-G.

On August 21, 2001, applicant filed a request for continued examination (RCE) under 37 CFR 1.114. The RCE was accompanied by a submission (including a response in part to the protest) and the fee for filing an RCE. Since the RCE withdraws the notice of allowance, the petition under 37 CFR 1.292 (and the protest) is timely.

On January 18, 2002, applicant filed a response to the petition and the protest.

On October 24, 2003, a requirement for information was mailed. The paper was returned as undeliverable. On November 19, 2003, a change of correspondence address was filed as a result of a telephone communication with applicant's attorney. Accordingly, on November 24, 2003, the requirement for information was re-mailed to the new correspondence address.

On December 31, 2003, applicant filed a response to the requirement for information. On March 18, 2004, a supplemental response to the requirement for information was filed.

37 CFR 1.292(a) reads, in part, as follows:

When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a *prima facie* showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Director to determine whether a public use proceeding should be instituted. (Emphasis added.)

A review of the petition under 37 CFR 1.292 reveals that it does not contain any supporting affidavits or declarations. While Exhibit C is an affidavit, it is an affidavit by applicant that was submitted in the litigation and it does not support the allegations in the petition. Thus, the petition fails to comply with the requirements of 37 CFR 1.292.

Petitioner is given **TWO MONTHS** from the mail date of this notice to supply the supporting affidavits or declarations required by 37 CFR 1.292. This time period is **not extendable** under 37 CFR 1.136(a) or (b). Failure to timely reply to this notice, by supplying the supporting affidavits or declarations required by 37 CFR 1.292, will result in the dismissal of the petition under 37 CFR 1.292.

Telephone inquiries specific to this matter should be directed to Eugenia Jones, Senior Legal Advisor, at (703) 306-5586.

Fred A. Silverberg

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy



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